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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,224

08/03/2006

Bruce Dean

MAGN 001-04

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Norris, Jerome  
1901 Pennsylvania Ave NW Ste 305  
Washington, DC 20006

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,224	<b>Applicant(s)</b> DEAN ET AL.	
	<b>Examiner</b> Kyle Grabowski	<b>Art Unit</b> 3725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 6-10 and 14-16 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-5 and 11-13, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
2. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 recites the same structure verbatim from claim 9 from which it depends.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (US 7,225,568) in view of Roth et al. (US 6,423,391).

6. In respect to claim 1, Rizzo et al. disclose an adhesive-backed magnet comprising: a magnetizable base member 110 (Col. 2, 65 – Col. 3, 4, Fig. 2) having a first portion 115 having a material receptive layer (printable sheet material) (Col. 3, 26-28) with printed material 119 printed thereon (Fig. 1); an adhesive layer 120; and a liner layer 130 non-permanently bonded to the adhesive layer 120 (Col. 3, 51-53, Fig. 2).

Although Rizzo et al. discloses that the adhesive may be applied in only certain areas (Col. 3, 48-50) it is not explicitly disclosed that the adhesive layer contains a *plurality* of non-adhesive voids or openings however Roth et al. teach providing a first strong adhesive 20b having a plurality of voids therein (filled with weak adhesive 20a) (Col. 8, 47-67, Fig. 9) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the adhesive layer taught in Rizzo et al. with a plurality of voids or openings in view of Roth et al. to effectively vary the adhesive strength, for example creating a low adhesion force along a trailing edge of a label to allow the label to be easily peeled (Col. 3, 34-47, Rizzo et al.)

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7. In respect to claims 2 and 3, Roth et al. teaches providing the non-adhesive voids or openings along one section and across only a portion of the adhesive as stated above (Fig. 9).

8. In respect to claims 4 and 5, Rizzo et al. further disclose several adhesive-backed magnets which are separated from a master sheet therefore inferring cutting through the adhesive layer to form magnets 110 (Fig. 7). If the applicant wishes to argue that Rizzo et al. does not alone disclose scoring or perforation through the adhesive layer, Roth et al. discloses the label as taught is cut from a main sheet and provided as A, B, or C, (Fig. 1) whereby the adhesive layer is cut through (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the plurality of labels taught in Rizzo et al. (Fig. 7) as cut from a single layer sheet as taught in Roth et al to efficiently and ecumenically create a plurality of labels. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art.

9. In respect to claims 6-10, Rizzo et al. in view of Roth et al. disclose all of the claimed subject matter. Claims 6-10 are identical to claims 1-5.

10. In respect to claims 11-13, Rizzo et al. in view of Roth et al. disclose all of the claimed subject matter for the reasons stated above, and additionally, Rizzo et al. discloses that the adhesive layer 120 may have a silicone tackified rubber coating (release liner) atop its adhesive (Col. 3, 41-48). The liner layer 130 as described above is synonymous to release liner disposed on the adhesive 120.

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11. In respect to claims 14-16, Rizzo et al. in view of Roth et al. disclose all of the claimed subject matter. Claims 14-16 are identical to claims 11-13.

12. In respect to claims 17-21, Rizzo et al. in view of Roth et al. disclose all of the claimed subject matter for the reasons stated above, and additionally that the liner layer 130 may be printed thereon with indicia 131 (Col. 3, 51-56, Fig. 1) therefore making the liner layer 130 synonymous with a second printed surface layer.

13. In respect to claim 22, Rizzo et al. further disclose usage of the first printed layer 117 as an advertisement and the second printed layer, upon the liner layer, a coupon (Fig. 5).

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/  
Examiner, Art Unit 3725

/Dana Ross/  
Supervisory Patent Examiner, Art  
Unit 3725